

## REMARKS

### I. PRELIMINARY REMARKS

Claims 8 and 23 have been amended. No claims have been canceled. Claims 52-65 have been added. Claims 8-29 and 52-65 remain in the application. Claims 10, 15, 17, 24 and 27 have been withdrawn from consideration.<sup>1</sup> Reexamination and reconsideration of the application, as amended, are respectfully requested.

### II. THE NEW MATTER ISSUE RAISED IN THE ADVISORY ACTION

Independent claims 8 and 23 have been amended to include the phrase "configured to bend out of the predefined bend in response to an application of a force and return to the predefined bend in response to removal of the force." The November 4, 2004 Advisory Action appears to indicate that this amendment may constitute new matter. To that end, applicant respectfully notes that this aspect of the claimed inventions is described in the specification at, for example, page 20, line 20 to page 21, line 11 and page 24, lines 24-31.<sup>2</sup>

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<sup>1</sup> Applicant respectfully submits that newly presented claims 55, 59 and 61 should also be withdrawn from consideration.

<sup>2</sup> Although the specification does not include the above-quoted phrase, the "claimed subject matter need not be described *in haec verba* in the specification in order for that specification to satisfy the description requirement." *In re Smith and Hubin*, 178 USPQ 620, 624 (CCPA 1973). Rather, applicant need only convey to those skilled in the art that, as of the filing date sought, he or she was in possession of the claimed invention. "One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention." *Lockwood v. American Airlines, Inc.*, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

### III. PRIOR ART REJECTIONS

#### A. The Rejections

Claims 8, 9, 11, 13, 14, 16, 18-23, 25, 28 and 29 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,322,064 to Lundquist (the Lundquist '064 patent). Claims 12 and 26 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Lundquist '064 patent and U.S. Patent No. 5,306,245 to Heaven (the Heaven '245 patent). The rejections under 35 U.S.C. §§ 102 and 103 are respectfully traversed. Reconsideration thereof is respectfully requested.

#### B. The Cited References

The Lundquist '064 patent discloses a variety of catheters. Referring to the catheter 501 illustrated in Figures 35B and 35C, the Lundquist '064 patent states:

Let it be assumed that it is desired to place a desired bend in the tractable or curve section 511b. This is accomplished by holding the catheter 501 in one hand and holding the tractable section 511b in the other hand and grasping the tractable section 511b between two fingers of the other hand and placing a curvature or bend in the direction desired. This section 511b is tractable or malleable and retains at least a portion of the curvature or bend placed in the same primarily because of the malleability of the stainless steel used in that section. Thus, a preform is placed in the section 511b.

[Column 23, lines 50-61.] In other words, the Lundquist '064 patent discloses a catheter having a section that will **hold its shape after** being bent and released by the physician.

The Heaven '245 patent discloses a device including a tubular member 2, which is supported on a catheter 15, and a wire 8. The tubular member 2 includes a hinge 6 that is defined by a cutout 7. The hinge 6 causes the catheter 15 to bend in a single plane in response to the application of tension on the wire 8. Applicant respectfully submits that the tubular member 2 is not, as asserted in the Office Action, "biased to a predetermined curvature." [Office Action at page 4.] To the contrary, the tubular member 2 only bends in

the manner illustrated in Figure 3 when tension is applied to the wire 8. [Column 5, lines 17-19.]

### C. Discussion

Independent claim 8 and 23 call for respective combinations of elements including, *inter alia*, “a main body portion ... including a preshaped portion having a predefined bend” and “**configured to bend out of the predefined bend in response to an application of a force and return to the predefined bend in response to removal of the force.**” The combination defined by claims 9, 11, 13, 14, 16 and 18-22 include, *inter alia*, the elements recited in claim 8, and the combinations defined by claims 25, 28 and 29 include, *inter alia*, the elements recited in claim 23. Applicant respectfully submits that the cited references fail to teach or suggest the claimed combinations.

For example, as noted previously, the Lundquist tractable section 511b is not preshaped and it does not have a predefined bend. Instead, the tractable section 511b is malleable and, accordingly, bends in response to an application of force applied by the physician and “**retains** at least a portion of the curvature or bend” **after being released** by the physician. [Column 23, lines 57-60, *emphasis added*; see also column 24, lines 43-45.]

As the Lundquist '064 patent fails to teach or suggest each and every element of the respective combinations recited in independent claims 8 and 23, applicant respectfully submits that claims 8, 9, 11, 13, 14, 16, 18-23, 25, 28 and 29 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

Turning to claims 12 and 26, applicant respectfully submits that the Heaven '245 patent fails to remedy the aforementioned deficiencies in the Lundquist '064 patent with respect to independent claims 8 and 23. Claims 12 and 26 are, therefore, patentable for at least the same reasons as independent claims 8 and 23 and the rejection of claims 12 and 26 under 35 U.S.C. § 103 should also be withdrawn.

#### **IV. NEWLY PRESENTED CLAIMS 52-65**

Newly presented claim 52 depends from independent claim 23 and is patentable for at least the same reasons as claim 23.

Newly presented claim 53 calls for a combination of elements comprising "a main body portion defining a proximal end and a distal end and including a preshaped portion having a predefined bend between the proximal and distal ends," "a deflectable portion, associated with the distal end of the main body portion and deflectable relative to the main body portion, including a steering spring defining a distal end and a proximal end, the proximal end of the steering spring being located distal of the preshaped portion" and "at least one operative element carried by the deflectable portion." Applicant respectfully submits that the cited references fail to teach or suggest such a combination and that claims 53-65 are patentable thereover.

#### **V. CLOSING REMARKS**

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such

fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

11/9/04

Date

**Henricks, Slavin & Holmes LLP**

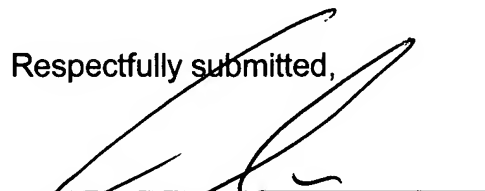
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Respectfully submitted,



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